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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,479	09/28/2001	David Lark	29757/P-561	6461

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EXAMINER

ONEILL, MICHAEL W

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,479

Applicant(s)

LARK, DAVID

Examiner

Michael O'Neill

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1-4 and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Odyssey gaming machine by Silicon Gaming, Inc. circa 1997; Scott et al. Des. 395,463; Hedrick et al., USPN 6,135,884 and Carmean, USPN 4,517,654.

Scott et al., Hedrick et al. and Carmean disclose, teach and suggest to one of ordinary skill in the art the hardware, cabinetry and software to have an operational video gaming machine.

The Odyssey gaming machine by Silicon Gaming, Inc. discloses, teaches and suggests to one of ordinary skill in the art the results of graphical processing programming techniques. As shown, results of these programming yield video reel slot machine that looks like a vintage mechanical reel slot machine; modern video slot machines; virtual dealer hands which toss virtual playing cards, these cards spin across a virtual table felt and the project faceward to reveal the card value and suit to the player in order to play a video poker game; and a virtual keno hopper with an exit tube that directs the keno balls to move from the hopper to the playfield and land on the

Art Unit: 3713

appropriate numbered spot. The keno game could easily be modified for a bingo game because keno and bingo are quite similar lot match game, bingo just adds a pattern that has to be match in order to win.

One of ordinary skill in the art given the knowledge of the hardware, software and cabinetry involved with gaming machines and the knowledge of the results presented in the Odyssey gaming machine would find the claimed inventions as obvious in view of these references viewed as a whole.

Re. claims 12 and 17 multiplicity of like parts is obvious to one of ordinary skill in the art, see the St. Regis Paper Co. v. Bemis, 193 USPQ 8 (7th Cir. 1977).

With respect to claims 21-24, these claims appear to be directed to what is known in the art as the "ROM" chips that are attached to the motherboard of the gaming machine and supply the gaming machine with the data needed for the gaming machine to operate as a gaming machine. These chips are usually regulated by local regulations and must be approved by the local regulatory commission prior to being placed within a gaming machine. The use of ROM chips is the only way gaming machines can operate legally within the local jurisdictions of the United States. Therefore, to incorporate the teachings above into ROM chips would be obvious to one skilled in the art; otherwise, the

Art Unit: 3713

gaming machine could not legally operate in a casino within the United States.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over art as applied to claim 1 above, and further in view of Pascal et al., USPN 6,287,202.

In figure 1, Pascal et al. teaches how one of ordinary skill in the art could network a series of gaming machines. One skilled in the art would find it obvious to network the gaming machines taught by the aforementioned prior art of record used in the rejection above based on the teachings found in Pascal et al. as one example of networking gaming machines.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 5 above, and further in view of Alcorn et al. USPN 6,104,815.

Alcorn et al. discloses, teaches and suggests the instrumentalities needed to get gaming machines connected to the Internet. Based on the teachings of Alcorn et al. and the knowledge one skilled in the art has with respect to networking gaming machines as shown by example with Pascal et al.; it would have been obvious to connect the taught gaming machines as taught and suggested by the aforementioned prior art of record used above to the Internet with the technology taught and suggested by Alcorn et al.

Response to Arguments

Applicant's arguments filed 1-21-05 have been fully considered but they are not persuasive.

First, the Examiner respectfully disagrees with the synopsis of the cited reference. Particularly, the Examiner has an issue with the Applicant's allegation that just the Brochure for the Odyssey Gaming Machine is the basis for the rejection. The Brochure is proof that the machine existed prior to the critical date. Had the Examiner and the Office had the machine and the means to deliver the machine to the Applicant, then that is what would have been done. However, the Office nor the Examiner have the instrumentalities or processes in place to accomplish such a feat. Therefore, it is incumbent on the Applicant is deemed with the all knowledge and means that one of ordinary in the art would possess to if they disagree with the Examiner's understanding of the prior art to provide contra evidence thereof in the form of a declaration under Rule 132.

In response to Applicant's contention that all claim limitations are not taught by the prior art of record, the Examiner respectfully disagrees. For instance, the Applicant alleges the prior art of record lacks in disclosing or suggesting: "(i) the display of a plurality of playing cards where the playing cards change from displaying one of card backs

Art Unit: 3713

and card fronts to displaying a portion of a display object inside the playing cards; and, (ii) wherein the portions of the display object create an identifiable image." As shown and thus known to those skilled in the art if they would just observe the Odyssey GM a pair of white gloved hands toss five card toward the player similar to how an actual dealer deals: the backs of the cards are first shown spinning toward the player. Then in order for the player to see the virtual cards dealt the cards flip to exposed the face of the card. Next the player proceeds to play the hand. Finally, all bets are resolved. Thus if one skilled in the art looks at the operation of the machine and looks at the claims simultaneously one skilled in the art would observe: i) the display of a plurality of playing cards where the playing cards change from displaying one of card backs and card fronts (the cards are dealt when the backs showing, then flip to showing the face) to displaying a portion of a display object inside the playing cards (once flip the cards rank and suit are show, i.e. the objects); and, (ii) wherein the portions of the display object create an identifiable image (players can readily identify and understand a card's rank and suit). Thus, the claimed limitations are found within the prior art.

In response to the lack of motivation contention raised by the Applicant, the Examiner recognizes that obviousness can only

Art Unit: 3713

be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837

F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is the demonstration of the existence of such a machine as the Applicant's are reciting in the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

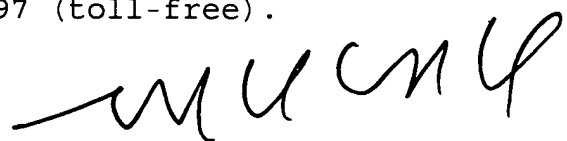
Art Unit: 3713

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL O'NEILL
PRIMARY EXAMINER